Application No. 10/074,162
Amendment dated October 6, 2004
Reply to Final Office Action dated August 9, 2004

Remarks/Arguments

The preceding amendments and following remarks are submitted in response to the Final Official Action of the Examiner mailed August 9, 2004. Claims 1-7, 9-21, 23-24 and 26-36 remain pending. Claim 36 has been added. Claim 25 has been canceled without prejudice as being drawing to a non-elected invention. Reconsideration, examination and allowance of all pending claims are respectfully requested.

The undersigned would like to thank the Examiner for the courtesies extended during the telephonic interview on October 6, 2004. The Examiner appeared to recognize that claim 1 was substantially different from Nagano. However, the Examiner indicated that he needed further time to consider whether claim 1 is patentable over Nagano and the other art of record. Claims 27 and 28 were also discussed. The Examiner suggested filing this Amendment-After-Final for further consideration.

In paragraph 13 of the Final Office Action, the Examiner indicated that claims 13-21, 23, 26 and 31-35 are allowed. In paragraph 14 of the Final Office Action, the Examiner indicated that claim 7 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

In paragraph 15 of the Final Office Action, the Examiner indicated that Applicant's arguments with respect to claims 1-7, 9-12, 24 and 27-30 have been considered but are moot in view of the new ground(s) of rejection.

In paragraph 3 of the Final Office Action, the Examiner rejected claims 1-4, 6 and 10 under 35 U.S.C. §102(b) as being anticipated by Nagano (U.S. Patent No. 5,430,627). After careful review, and for a variety of reasons, Applicant must respectfully disagree. Claim 1 recites:

> 1. A lighting apparatus for receiving an elongated light source, comprising:
>
> an elongated member including a first material and a second material, the first material being at least semi-transparent and the second material being substantially non-transparent, the elongated member having a cavity for receiving the elongated light source, the cavity being at least partially defined by at least a portion of the first material that extends from the cavity to two or more separate outer surface regions of the elongated member, wherein at least part of the outer surface between the two or more separate regions is substantially non-transparent.

(Emphasis Added). As can be seen, claim 1 recites an elongated member that has a cavity for receiving an elongated light source, wherein the cavity is at least partially defined by at least a portion of the first material that extends from the cavity to two or more separate outer surface regions of the elongated member, wherein at least part of the elongated member between the two or more separate regions is substantially non-transparent.

Some illustrative elongated members having a cavity that is at least partially defined by at least a portion of the first material that extends from the cavity to two or more separate outer surface regions of the elongated member, can be found in, for example, Figures 37, 43 and 49 of the present application, which are reproduced below for the convenience of the Examiner:

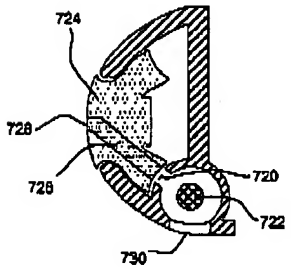


FIG. 37

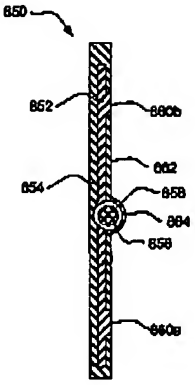


FIG. 43

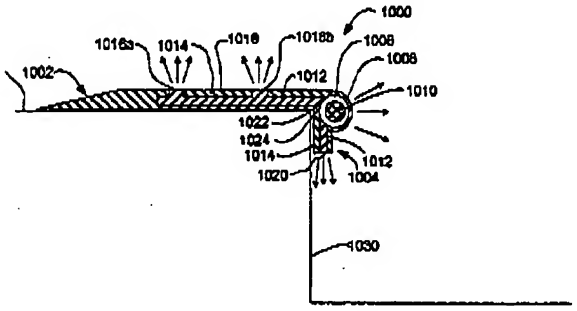


FIG. 49

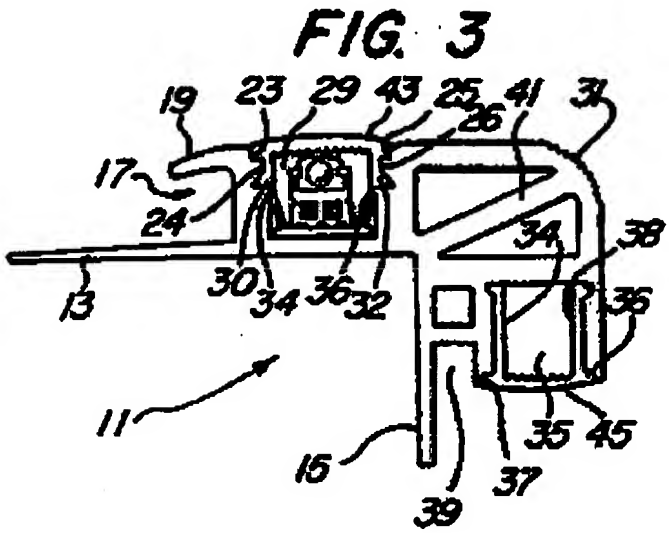
Shown in each of these illustrative embodiments is a cavity that is at least partially defined by at least a portion of the first material that extends from the cavity to two or more separate outer surface regions of the elongated member, wherein at least part of the elongated member between the two or more separate regions is substantially non-transparent.

With respect to claim 1, the Examiner states that Nagano discloses an:

> elongated member having a cavity (29 in Fig. 3) for receiving the elongated light source, the cavity being at least partially defined by at least a portion of the first material (43) that extends from the cavity (29) to two or more separate outer surface regions (13, 19, 31, 41 and 15 in Fig. 3) of the elongated member (11), wherein at least part of the outer surface (31) between the two or more separate regions is substantially non-transparent (vinyl material of 31 is non-

transparent).

(Final Office Action, paragraph 4). For the convenience of the Examiner, Figure 3 of Nagano is reproduced below:



The Examiner takes the position that the cavity (29) is at least partially defined by at least a portion of a first material (43) (i.e. at least semi-transparent material) that extends from the cavity (29) to two or more separate outer surface regions (13, 19, 31, 41 and 15 in Fig. 3) of the elongated member (11), wherein at least part of the outer surface (31) between the two or more separate regions is substantially non-transparent (vinyl material of 31 is non-transparent). However, and as can clearly be seen in Figure 3 of Nagano, the first material 43 (i.e. the at least semi-transparent material) does not extend to two or more separate outer surface regions (13, 19, 31, 41 and 15 in Fig. 3) of the elongated member (11), as the Examiner suggests. Rather, it

appears that each of the two or more separate outer surface regions cited by the Examiner, namely regions 13, 19, 31, 41 and 15 in Fig. 3, are all made from a non-transparent material. In view of the foregoing, claim 1 is believed to be clearly patentable over Nagano. For similar and other reasons, dependent claims 2-6, 9-12 are also believed to clearly patentable over Nagano.

In paragraph 10 of the Final Office Action, the Examiner rejected claims 9 and 27-30 under 35 U.S.C. §103(a) as being unpatentable over Nagano (U.S. Patent No. 5,430,627). For similar reasons to those given above, as well as other reasons, dependent claim 9 is believed to clearly patentable over Nagano.

With respect to claim 27, while Applicant respectfully disagrees with the Examiner's rejection, claim 27 has been amended to recite:

> 27. (Currently Amended) A method for making an elongated member for receiving an elongated light source, the elongated member having a viewing side and one or more non-viewing sides, the method comprising the steps of:
>
> co-extruding an elongated member with a first material and a second material, the first material being at least semi-transparent and the second material being substantially non-transparent, the elongated member having a cavity for receiving the elongated light source, the cavity being at least partially defined by at least a portion of the first material that extends from the cavity to two or more separate outer surface regions on [of] the viewing side of the elongated member, wherein at least part of the elongated member [outer surface] between the two or more separate regions on the viewing side is substantially non-transparent.

As can be seen, claim 27 recites that the elongated member has a view side and one or more non-viewing sides. Claim 27 further recites that the cavity is at least partially defined by at least a portion of the first material that extends from the cavity to two or more separate outer surface regions on the viewing side of the elongated member, wherein at least part of the elongated

member between the two or more separate regions on the viewing side is substantially non-transparent.

As noted by the Examiner, and with reference to Figures 11-12 of Nagano, the lens cover 245 includes a shield 249 that is made from an opaque material. The lens cover 245 is used to cover the second channel 35 in the embodiment of Figures 1-4 of Nagano (see, Nagano, column 5, lines 17-19). The purpose of the shield 249 is to "prevent glare of individual light fixtures from reaching the eye of someone approaching or using the staircase" (see, Nagano, column 5, lines 28-31). As can be seen, when the lens cover 245 is installed in the second channel 35 of the embodiment shown in Figures 1-4 of Nagano, the shield 249 prevents the eye of a user from seeing the exposed top surface 248, and thus the exposed top surface 248 is clearly not a viewing side. In fact, Nagano would appear to teach away from providing a cavity that is at least partially defined by at least a portion of the first material that extends from the cavity to two or more separate outer surface regions on the viewing side of the elongated member, wherein at least part of the elongated member between the two or more separate regions on the viewing side is substantially non-transparent, as recited in claim 27. In view of the foregoing, claim 27 is believed to be in condition for allowance.

Turning now to claim 28, which recites:

> 28. A lighting apparatus for receiving an elongated light source, comprising:
>
> an elongated member including a first material and a second material, the first material being at least semi-transparent and the second material being substantially non-transparent, the elongated member having a cavity for receiving the elongated light source, the cavity being at least partially defined by at least a

portion of the first material that extends from the cavity to an outer surface of the elongated member;

a bumper member; and

the elongated member further defining a slot for receiving the bumper member.

As can be seen, claim 28 recites a bumper member, and that the elongated member defines a slot for receiving the bumper member. In paragraph 10 of the Final Office Action, the Examiner states that the slot 39 in Figure 3 of Nagano corresponds to the slot recited in claim 28. However, slot 39 of Nagano is clearly not for receiving a bumper member, as recited in claim 28. According to Nagano, slot 39 is for receiving "carpet" (see, Nagano, column 3, lines 44-46). Furthermore, there would appear to be little motivation to provide a bumper in the slot 39 of Nagano, particularly since there would be little if any foot traffic at or near slot 39, and there would be little need for a bumper member at that location. In view of the foregoing, claim 28 is believed to be clearly patentable over Nagano. For similar and other reasons, dependent claim 29 is also believed to be clearly patentable over Nagano.

In paragraph 12 of the Final Office Action, the Examiner rejected claims 11-12 and 24 under 35 U.S.C. §103(a) as being unpatentable over Nagano (U.S. Patent No. 5,430,627) in view of Daniel (U.S. Patent No. 4,234,907) and Feldman et al. (U.S. Patent No. 5,753,381). The Examiner states that Nagano does not disclose that the light source is an electroluminescent wire, a linear emitting fiber or glow-in-the-dark material. However, the Examiner states that Daniel and Feldman teach a linear emitting fiber and glow-in-the-dark material as a light source. The Examiner concludes that it would have been obvious to one having ordinary skill in the art at the

time of the invention to substitute Nagano's light source with an electroluminescent wire, a linear emitting fiber or glow-in-the-dark material as Daniel and Feldman disclosed because an electroluminescent wire, a linear emitting fiber or glow-in-the-dark material could be used as a linear light source.

After careful review, Applicant must respectfully disagree. Nagano clearly teaches to use a number of point-light sources (as evidenced in column 1, lines 26-29) such as a string of light bulbs. More specifically, Nagano states:

> The preferred lighting fixture 61 is that disclosed in U.S. Pat. No. 5,045,981, incorporated by reference herein and shown in more detail in FIG. 9. Briefly, this light fixture employs a light bulb 62 inserted in a socket which is releasably secured to a carriage 63. The electrical contact to a pair of leads on the light bulb 62 is made by a pair of arcuate terminals fastened within the carriage 63. The terminals have one free end so that they may bend freely upon insertion of the socket within the carriage. The socket includes a depression configured to conform to the shape of the arcuate terminals, so that the terminals snap into the depression when the socket is inserted into the carriage 63. The leads extend across the depression to improve the electrical contact. The socket is further secured to the carriage 63 by a pair of grooves which mate to the carriage's guiding rails.
>
> According to the preferred embodiment, the lamp carriage 63 is attached to the base 171 of a metal wedge clip carriage 173, e.g., by gluing. The wedge clip carriage 172 includes two wings 172, 174 attached to the respective edges of the base and extending outwardly therefrom. The wings 172, 174 are springably attached to the base such that they may bend in an arc 176 about the position shown in FIG. 10a.
>
> FIGS. 10a-10d illustrate how the wedge clip carriage 173 is inserted into and retained by a cooperating channel such as 129. In FIG. 10a, the wedge clip carriage 173 is about to be inserted into the channel 129. In FIG. 10b, the wedge clip carriage 173 is initially being inserted into the channel 129, and the wings 172, 174 are being slightly forced inward against their bias towards the light fixture 61. In FIG. 10c, the wedge clip carriage 173 is almost completely inserted into the channel 129, and the wings 172, 174 have been forced inward by tangs 131, 133 located on a pair of relatively rigid interior channel walls 132, 134. FIG.

> 10d illustrates the wedge clip lamp carriage 173 completely inserted, in which position the wings 172, 174 have released outwardly against the walls 132, 134 and beneath the tangs 131, 133.
>
> With respect to channel 129, it will be observed, for example, from FIG. 10e, that the tangs 131, 133 are raised above the base of the channel 129 to a height sufficient such that the base 171 of the wedge clip carriages 173 will not bottom out as the spring clip sides or wings 172, 174 are pinched in by the tangs 131, 133, thereby permitting the carriages 173 to be snapped into the channel 129.

(Nagano, column 3, line 61 through column 4, line 40). As can be seen, Nagano clearly suggests using a number of point light sources (i.e. light bulbs). Moreover, much of the structure of Nagano is provided to accommodate the series of point light sources (see, for example, Figures 9, 10a-10d and 13 of Nagano). In view of the foregoing, Applicant does not believe it can readily be argued that it would have been obvious to replace the point light sources of Nagano, including all of the supporting structure which appears to be a main thrust of Nagano's disclosure, with an elongated light source such as an electro-luminescent wire, a linear emitting fiber or a glow-in-the-dark material, as the Examiner suggests.

Applicant would like to remind the Examiner that although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." *In re Mill*s, 916 F.2d at 682, 16 USPQ2d at 1432 (see, MPEP §2143.01). In the present case, there is no suggestion or motivation whatsoever in Nagano, Daniel or Feldman to replace the point light sources of Nagano, including all of the supporting structure which appears to be a main thrust of Nagano's disclosure, with an elongated light source such as an electro-luminescent wire, a linear emitting fiber or a glow-in-the-dark

material. For these and other reasons, claims 12, 13 and 24 are all believed to be clearly patentable over Nagano in view of Daniel and Feldman.

In view of the foregoing, Applicant believes that all pending claims 1-7, 9-21, 23-24 and 26-36 are now in condition for allowance. Reexamination and reconsideration are respectfully requested. If the Examiner believes it would be beneficial to discuss the application or its examination in any way, please call the undersigned attorney at (612) 359-9348.

Respectfully submitted,

Dated: October 6, 2004

Brian N. Tufte, Reg. No. 38,638
CROMPTON, SEAGER & TUFTE, LLC
1221 Nicollet Avenue, Suite 800
Minneapolis, MN 55403-2402
Telephone: (612) 677-9050
Facsimile: (612) 359-9349